

## REMARKS

### **A. Background**

Claims 14-21, 23-28, 30, 31, 38-47, 49-51, 55, 56, and 58-63 were pending in the application at the time of the Office Action with claims 16, 17, 25, 41, 44, 49, and 51 being withdrawn from consideration. The Office Action rejected claims 14, 15, 18-21, 23 and 24 as being anticipated by cited art. Claim 63 was objected to as being dependent upon a rejected base claim. Claims 26-28, 30, 31, 38-40, 42, 43, 45-47, 50, 55, 56, and 58-62 were allowed. By this response Applicant has amended claim 14. As such, claims 14-21, 23-28, 30, 31, 38-47, 49-51, 55, 56, and 58-63 are presented for the Examiner's consideration in light of the following remarks with claims 16, 17, 25, 41, 44, 49, and 51 being withdrawn from consideration.

### **B. Proposed Amendments**

Claim 14 has been amended herein to recite "the stem and the bearing plate being fabricated as a monolithic piece of material so that there is no mechanical connection removably coupling the stem to the bearing plate." This limitation is supported by at least Figures 12A-C and 17. The specification has been amended to provide antecedent basis for the term "monolithic." Applicant submits that the amendments to the claims and the specification do not add new matter and entry of the amendments is respectfully requested.

### **C. Examiner Interview**

Applicant would like to thank the Examiner for the courtesy of the telephonic interview conducted on January 16, 2007. During the interview, the amendment for claim 14, as set forth herein, was discussed and approved by the Examiner. The Examiner also agreed that due to the

amendment to claim 14, claim 14 is now distinguished over prior art where the stem is removably coupled to the bearing plate.

**D. Rejection on the Merits**

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. MPEP § 2131

Pages 2 and 3 of the Office Action reject claims 14 and 18-20 under 35 US C § 102(b) as being anticipated by U.S. Patent No. 5,019,103 to Van Zile et al. Applicant respectfully traverses the rejection.

Van Zile teaches a modular prosthetic system for mounting a variety of styles of wedges to a tibial tray to correct for bone deficiencies. See Van Zile Abstract. As shown in Figures 1 and 3, cannulated screws 48 are inserted through a tray 22 and screwed into a wedge 46 to secure wedge 46 to tray 22. See col. 5, lines 57-68. Once wedge 46 and tray 22 are secured together, bone screws 50 are then received through the bores of cannulated screws 48 and screwed into the proximal end of the tibia to secure the system to the bone. See col. 6, lines 14-20. A male stem 36 can also extend down from tray 22 and be received within a female stem 39 that has been implanted into the bone for added stability. See col. 5, lines 13-20.

The Office Action equates cannulated screw 48 and tray 22 of Van Zile with the “stem” and “bearing plate,” respectively, of the invention as recited in claim 14. However, because cannulated screw 48 in Van Zile is separate from tray 22 and is used to removably secure wedge

46 to tray 22 by threaded engagement, Van Zile does not disclose or suggest “the stem and the bearing plate being fabricated as a monolithic piece of material so that there is no mechanical connection removably coupling the stem to the bearing plate,” as recited in amended claim 14. Furthermore, cannulated screw 48 in Van Zile is used so that a variety of different configurations of wedges 46 can be removably mounted to tray 22. One object of Van Zile is to allow different styles of wedges to be mounted to the tibial tray to correct for different bone deficiencies when mounting the tibial tray. Applicant asserts that it would not be obvious to modify Van Zile to make cannulated screw 48 a unitary member with tray 22 since such a modification would preclude the ability to mount different wedges 46 to tray 22 and thus destroy an intended object of Van Zile.

Claims 18-20 depend from claim 14 and thus incorporate the limitations thereof. As such, applicant submits that claims 18-20 are also distinguished over the cited art for at least the same reasons as discussed above with regard to claim 14. As such, withdrawal of the anticipation rejection of claims 14 and 18-20 in view of Van Zile is respectfully requested.

Page 3 of the Office Action rejects claims 14, 21, and 23-24 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,102,954 to Albrektsson et al. Applicant respectfully traverses this rejection.

As seen in Figure 6, Albrektsson teaches a prosthesis for replacement of a tibial side of a knee joint, including a plate 30 that is placed on the bone. Before plate 30 is placed on the bone, a screw fixture 20 having a threaded bore is secured within the bone and a horizontal channel is cut in the bone. Plate 30 has a horizontal tube-like fixture element 31 corresponding to the horizontal channel. Plate 30 is then placed on the bone by sliding fixture element 31 into the channel until a hole 22 within plate 30 aligns with the bore of screw fixture 20. A screw 21 is

then inserted through hole 22 and screwed into the bore of screw fixture 20 to secure plate 30 to the bone.

The Office Action equates screw fixture 20 and plate 30 of Albrektsson with the “stem” and “bearing plate,” respectively, of the invention as recited in claim 14. However, because screw fixture 20 in Albrektsson is separate from plate 30 and is removably coupled to plate 30, Albrektsson does not teach or suggest “the stem and the bearing plate being fabricated as a monolithic piece of material so that there is no mechanical connection removably coupling the stem to the bearing plate,” as recited in amended claim 14. Furthermore, because fixture element 31 of Albrektsson must first be slid into the horizontal channel before hole 22 within plate 30 can align with the bore of screw fixture 20, Applicant asserts that it would not be obvious to modify Albrektsson to make screw fixture 20 a unitary member with plate 30. By so doing, screw fixture 20 would hit against the bone and prevent fixture element 31 from sliding into the horizontal channel, thus rendering the Albrektsson prosthesis unsatisfactory for its intended purpose.

Claims 21 and 23-24 depend from claim 14 and thus incorporate the limitations thereof. As such, applicant submits that each of these dependent claims is also distinguished over the cited art for at least the same reasons as discussed above with regard to claim 14. As such, withdrawal of the anticipation rejection of claims 14, 21, and 23-24 in view of Albrektsson is respectfully requested.

Pages 3 and 4 of the Office Action reject claims 14 and 15 under 35 USC § 102(e) as being anticipated by U.S. Publication No. 2004/0106928 to Ek.<sup>1</sup> Applicant respectfully traverses this rejection.

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<sup>1</sup> Because Ek is only citable under 35 U.S.C. § 102(e), Applicant does not admit that Ek is in fact prior art to the claimed invention but reserves the right to swear behind Ek if necessary to remove it as a reference.

As seen in Figure 7, Ek teaches a condylar implant 130 including an angled bearing surface 20, an intermediate mount 21 and a fixation element 22, all initially separated from one another. Bearing surface 20 and intermediate mount 21 are press-fit together and mounted on fixation element 22. Fixation element 22 has external helical threads that allow fixation element 22 to be screwed into the bone from below.

The Office Action equates intermediate mount 21 and bearing surface 20 of Ek with the “stem” and “bearing plate,” respectively, of the invention as recited in claim 14. However, because intermediate mount 21 in Ek is separate from bearing surface 20 and is removably coupled thereto, Ek does not disclose or suggest “the stem and the bearing plate being fabricated as a monolithic piece of material so that there is no mechanical connection removably coupling the stem to the bearing plate,” as recited in amended claim 14.

Claim 15 depends from claim 14 and thus incorporates the limitations thereof. As such, applicant submits that claim 14 is also distinguished over the cited art for at least the same reasons as discussed above with regard to claim 14. As such, withdrawal of the anticipation rejection of claims 14 and 15 with regard to Ek is respectfully requested.

Claims 26-28, 30, 31, 38-40, 42, 43, 45-47, 50, 55, 56, and 58-62 were allowed in the Office Action and thus are not discussed.

No other objections or rejections are set forth in the Office Action.

#### **D. Conclusion**

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art.

Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 14-21, 23-28, 30, 31, 38-47, 49-51, 55, 56, and 58-63 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 23<sup>rd</sup> day of January 2007.

Respectfully submitted,

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